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EXAMINER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/517,444	Applicant(s) OHMORI ET AL.	
	Examiner EMILE SU	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 and 34-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-33 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>129/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office Action is in response to communications filed on March 26, 2009. Claims 1-18 and 34-45 are withdrawn.
2. **Claims 19-33 and 46-48** are currently pending and are rejected.

Election

3. Applicant's election without traverse of Claims 19-33 and 46-48 in the reply filed on March 26, 2009 is acknowledged.
4. Claims 1-18 and 34-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 26, 2009.

Claim Objections

5. **Claim 48** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The language of the claim is indeterminate whether it is an independent claim or dependent claim.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 19-33 and 46-48** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Concerning Claims 19 and 47, data structures (i.e. a reading unit) not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. *See In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things". They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. *See In re Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

The claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, it is descriptive material per se and hence nonstatutory. Since a computer program is merely a set of instructions capable of being

executed by a computer, the computer program itself is not a process and without the computer-readable medium needed to realize the computer program's functionality the claim is nonstatutory functional descriptive material.

The subject matter of Claims 19 and 47, as claimed, is descriptive material per se and hence nonstatutory.

As to Claims 20-33, see discussion of Claim 19 above. These depending claims repeat the same U.S.C. §101 deficiency as in Claim 19 and are rejected in the like manner above.

As to Claim 48, see discussion of Claim 47 above. This depending Claim inherits the same U.S.C. §101 deficiency as in Claim 47 and is rejected in the like manner above.

Concerning Claim 46, Applicant's method claim is non-statutory for failing the machine-or-transformation test. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, in order for a method to be considered a "process" under 35 U.S.C. §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, Claim 46 fails prong (1) because there is no positive recitation of structure or machine tied to performed the claim steps. Additionally, the claim fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112, Second Paragraph

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 20-33 and 46-48** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claiming Both System and Method

Regarding Claim 20, Applicant's recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims an "obtaining unit" while also claiming a process of using the component "reads the digital content data". A single claim which purports to be both a product or machine and a

process is ambiguous and is rejected for failing to particularly point out and distinctly claim the invention. See *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

Claim 21 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a “reading unit” while also claiming a process of using the component “reads the right information”.

Claim 22 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a “reading unit” while also claiming a process of using the component “reads the right information”; claims a “judgment unit” while also claiming a process of using the component “compares the rental-use time limit ... and judges”.

Claim 23 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a “reading unit” while also claiming a process of using the component “reads the right information”; claims a “judgment unit” while also claiming a process of using the component “compares an elapsed data and time ... and judges”.

Claim 24 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a “reading unit” while also claiming a process of using the component “reads the right information”; claims a “judgment unit” while also claiming a process of using the component “counts a number of times ... and judges”.

Claim 25 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a “reading unit” while also claiming a process of using the component “reads the right information”; claims a “judgment unit” while also claiming a process of using the component “compares the first identification information ... and judges”.

Claim 26 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims an “obtaining unit” while also claiming a process of using the component “reads the digital content data ... receives the content key ... and decrypts ... to generate”.

Claim 27 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims an “obtaining unit” while also claiming a process of using the component “reads the digital content data ... receives the content key ... and decrypts ... to generate”.

Claim 28 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a “reading unit” while also claiming a process of using the component “reads the right information”.

Claim 29 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a “reading unit” while also claiming a process of using the component “reads the right information”.

Claim 32 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a “request unit” while also claiming a process of using the component “sends to the semiconductor memory”.

Claim 33 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a “request unit” while also claiming a process of using the component “sends to the semiconductor memory”.

b) Unclear Scope

Regarding Claim 20, Applicant recites “wherein the storage medium” and “information stored in the area of the semiconductor memory”. However, Claim 20 depends from Claim 19, and the scope of Claim 19 is directed towards a “playback apparatus”. While applicant is attempting to further narrow the claim by describing the “storage medium” and the “semiconductor memory”, the two entities are not part of the playback apparatus. It is unclear to one of ordinary skill in the art as to what Applicant actually regards as the claimed invention. The scope of the invention is unclear and the description regarding the “storage medium” and “semiconductor memory” is not given patentable weight for the purpose of prior art examination.

As to Claims 21-27 and 29, see discussion of Claim 20 above. These claims repeat the same U.S.C. §112 deficiency of describing the “storage medium” and “semiconductor memory” that are not part of the playback apparatus recited in Claim 19. The limitations, therefore, render the claims to be unclear as to what Applicant actually

regards as the claimed invention and is not given patentable weight for the purpose of prior art examination.

c) Insufficient Antecedent

Regarding Claims 20, 21, 26, and 27, Applicant recites “the storage medium”. It is unclear whether the phrase is particularly referring to “a portable storage medium” in the preamble of Claim 1 or referring to a different medium. There is insufficient antecedent basis for this limitation in the claims.

Regarding Claim 20-26 and 29, Applicant recites “the area of the semiconductor memory”. It is unclear whether the phrase is particularly referring to “an area of portable semiconductor memory” in Claim 1 or referring to a different semiconductor memory. There is insufficient antecedent basis for this limitation in the claims.

Regarding Claims 26, 27, and 30-33, Applicant recites “the semiconductor memory”. It is unclear whether the phrase is particularly referring to “an area of portable semiconductor memory” in Claim 1 or referring to a different semiconductor memory. There is insufficient antecedent basis for this limitation in the claims.

Further regarding Claims 46 and 47, Applicant recites “the storage medium”. It is unclear whether the phrase is particularly referring to “a portable storage medium” in the preamble of the claim or referring to a different semiconductor memory. There is insufficient antecedent basis for this limitation in the claims.

d) Unclear Steps

Further regarding Claim 21, Applicant recites “information showing a limitation to be imposed”. Information that is processed within a computer does not

“show” anything, as a computer does not “see”. It is unclear to one of ordinary skill in the art how the claimed invention “shows” information.

e) Clarity of Language

Regarding Claims 46 and 47, Applicant recites “a reading step of securely reading right information relating to a right to use the digital work, from an area of a portable semiconductor memory”. It is unclear whether the phrase means the act of reading is performed by a semiconductor memory or reading out information that was stored on the semiconductor memory.

Regarding Claim 48, Applicant recites “The playback program of Claim 47” in the first line of the claim. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out whether applicant is claiming a depending claim that depends from Claim 47 or an independent claim. *See In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989). The phrase will be understood as a depending claim for the purpose of prior art examination.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3685

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Applicant is reminded that the structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

14. **Claims 19-33 and 46-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,236,971 B1 (hereinafter Stefik).

Examiner notes that Claims 19-33 and 46-48 are replete with non-functional descriptive material, functional or operational language, optional language, and intended use language. **These limitations are not given patentable weight for the purpose of prior art examination.** For example, Claim 19 recites “a reading unit operable to

securely read right information” which is representative of functional language (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)); Claim 21 recites “stores the right information including playback-limiting information showing a limitation to be imposed on playback of the digital work held by the storage medium” which is representative of non-functional descriptive material (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983); *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II); Claim 25 recites “and when the first identification information and the second identification information match, judges that the digital work identified by the first identification information is allowed to be used” which is representative of optional language (*In re Johnston*, 77 USPQ2d 1788 (CAFC 2006); MPEP §2106 II C); Claim 29 recites “a rental function of renting the storage medium for use in a storage-medium rental system, and the application area corresponding to the rental function is used to stored the right information” which is representative of intended use (*In re Casey*, 152 USPQ 235 (CCPA 1967)). Repeats of the cited examples can be found throughout the claims.

With respect to Claim 19, Stefik discloses:

a reading unit (see Stefik, Column 14 Lines 5-25; also see Column 9 Lines 55-67) operable to securely (see Stefik, Column 26 Lines 58-64) compare right information relating to a right to use the digital work (see Stefik, Column 30, Lines 58-67; also see Column 30 Line 50 through Column 32 Line 5), from an area of a portable semiconductor memory (see Stefik, Column 31 Lines 6-15; also see Column 7 Lines 47-65 and Column 14 Lines 5-25);

a judgment unit operable to judge whether the digital work is allowed to be used, based on the read right information (see Stefik, Column 14 Lines 5-25; also see Column 30 Line 14 through Column 32 Line 22 and Column 7 Lines 14-46);

an obtaining unit operable to obtain the digital work from the storage medium when the digital work is allowed to be used (see Stefik, Column 14 Lines 15-25; also see Column 34 Line 16 through Column 35 Line 4); and

a playback unit operable to playback the obtained digital work (see Stefik, Column 8 Lines 39-59; also see Column 7 Lines 47-65 and Column 35 Line 65 through Column 36 Line 33).

While Stefik discloses comparing the rights, Stefik does not specifically disclose a function of reading rights. Official Notice is taken that it is old and well known in the art to read information in order to make a comparison, because reading the information prevents corruption of the original source of the information.

As to Claim 20, see discussion of Claim 19 above. Stefik discloses the invention substantially as claimed. Stefik further discloses wherein the storage medium holds the digital work by storing therein digital content data that has been generated by encrypting the digital work using an encryption key (see Stefik, Column 9 Lines 39-54);

the right information stored in the area of the semiconductor memory includes a decryption key to be used to decrypt the digital content data, the decryption key corresponding to the encryption key (see Stefik, Column 38 Lines 7-9; also see Column 42 Lines 8-14);

the reading unit reads the right information including the decryption key (see Stefik, Column 42 Lines 3-7); and

when the digital work is allowed to be used, the obtaining unit reads the digital content data from the storage medium and decrypts the digital content data using the decryption key included in the read right information, to generate the digital work (see Stefik, Column 41 Line 53 through Column 42 Line 30).

As to Claim 21, see discussion of Claim 19 above. Stefik discloses the invention substantially as claimed. Stefik further discloses wherein the area of a the semiconductor memory stores the right information including playback-limiting information showing a limitation to be imposed on playback of the digital work held by the storage medium (see Stefik, Column 31 Lines 16-29);

the reading unit read the right information including the playback-limiting information (see Stefik, Column 31 Lines 16-29; also see Column 20 Line 60 through Column 21 Line 8); and

the judgment unit judges whether the digital work is allowed to be used, based on the playback-limiting information included in the read right information (see Stefik, Column 31 Lines 16-29).

As to Claim 22, see discussion of Claim 21 above. Stefik discloses the invention substantially as claimed. Stefik further discloses a time limit until when the rental agent allows the user to use the digital work (see Stefik, Column 21 Lines 56-59; also see Column 21 Line 28 through Column 22 Line 15).

As to Claim 23, see discussion of Claim 21 above. Stefik discloses the invention substantially as claimed. Stefik further discloses the rental-use period starting from a time at which the user firstly plays back the digital work (see Stefik, Column 21 Lines 28-44; also see Stefik Column 21 Line 28 through Column 22 Line 15).

As to Claim 24, see discussion of Claim 21 above. Stefik discloses the invention substantially as claimed. Stefik further discloses a number of times a user is allowed to play back the digital work (see Stefik, Column 31 Line 30-40; also see Column 20 Line 60 through Column 21 Line 7).

As to Claim 25, see discussion of Claim 19 above. Stefik discloses the invention substantially as claimed. Stefik further discloses wherein the storage medium stores first identification information identifying the repository digital work (see Stefik, Column 41 Lines 8-13; also Column 9 Lines 55-67 and Column 13 Lines 49-65);

the right information stored in the area of the semiconductor memory includes second identification information identifying the digital work (see Stefik, Column 41 Lines 34-49; also Column 25 Lines 34-41);

the reading unit reads the right information including the second identification information (see Stefik, Column 34-49; also see Column 14 Lines 5-25); and

the judgment unit compares the first identification information stored in the storage medium and the second identification information included in the read right information, and when the first identification information and the second identification information do not match, judges that the digital work identified by the first identification

information is allowed to be used (see Stefik, Column 41 Lines 34-49; also Column 14 Lines 5-25 and Column 25 Lines 34-41).

While Stefik discloses checking for a match against invalid authorization ID to prevent authorization, Stefik does not specifically disclose checking for a match against a valid authorization ID to allow authorization. It would have been obvious to one of ordinary skill in the art at the time of the invention to compare against a valid authorization ID list, because it is easier to maintain a valid list by a issuer since the issuer has no control of how many invalid ID are generated by illicit third-parties.

As to Claim 26, see discussion of Claim 25 above. Stefik discloses the invention substantially as claimed. Stefik further discloses wherein the storage medium holds the digital work by storing therein digital content data that has been generated by encrypting the digital work (see Stefik, Column 9 Lines 39-54);

the semiconductor memory further prestores, in the area, a device key unique to the semiconductor memory (see Stefik, Column 27 Line 45-49);

the right information stored in the area of the semiconductor memory includes an encrypted content key that has been generated by encrypting the content key using the device key (see Stefik, Column 28 Lines 41-62); and

the semiconductor memory further includes a decryption unit operable to decrypt the encrypted content key stored in the area using the device key to generate a content key, and output the generated content key (see Stefik, Column 28 Lines 52-55), and

when the digital work is allowed to be used, the obtaining unit reads the digital content data from the storage medium, receives the content key from the semiconductor

memory, and decrypts the read digital content data using the content key, to generate the digital work (see Stefik, Column 38 Lines 7-9).

Stefik does not specifically disclose encrypting content using a content key. Stefik does disclose encryption using an encrypting key (see Stefik, Column 28 Lines 41-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt content using an encryption key, because encryption keys are small and easy to transfer.

As to Claim 27, see discussion of Claim 25 above. Stefik discloses the invention substantially as claimed. Stefik further discloses wherein the storage medium holds the digital work by storing therein digital content data that has been generated by encrypting the digital work (see Stefik, Column 9 Lines 39-54), and further stores a disc key unique to the storage medium (see Stefik, Column 27 Line 45-49)

the right information stored in the area of the semiconductor memory includes an encrypted content key that has been generated by encrypting the content key using the device key (see Stefik, Column 28 Lines 41-62); and

the semiconductor memory further includes a decryption unit operable to decrypt the encrypted content key stored in the area using the device key to generate a content key, and output the generated content key (see Stefik, Column 28 Lines 52-55), and

when the digital work is allowed to be used, the obtaining unit reads the digital content data from the storage medium, receives the content key from the semiconductor memory, and decrypts the read digital content data using the content key, to generate the digital work (see Stefik, Column 38 Lines 7-9).

Stefik does not specifically disclose encrypting content using a content key. Stefik dose disclose encryption using an encrypting key (see Stefik, Column 28 Lines 41-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt content using an encryption key, because encryption keys are small and easy to transfer.

As to Claim 28, see discussion of Claim 19 above. Stefik discloses then invention substantially as claimed. Stefik further discloses an authentication unit operable to perform mutual authentication with the semiconductor memory (see Stefik, Column 27 Line 20 through Column 28 Line 40); and

wherein the reading unit reads the right information (see Stefik, Column 14 Lines 5-25; also see Column 9 Lines 55-67), when the mutual authentication is successful (see Stefik, Column 30 Lines 15-26).

As to Claim 29, see discussion of Claim 19 above. Stefik discloses the invention substantially as claimed. Stefik further discloses the reading unit reads the right information from the application area corresponding to the rental function (see Stefik, Column 14 Lines 5-25; also see Column 9 Lines 55-67).

Stefik dose not specifically disclose “wherein the area of the semiconductor memory ... is used to store the right information”. However, the limitation is not part of the claimed playback apparatus and does not fall under the scope of the claimed invention. The limitation is not given patentable weight for the purpose of prior art examination.

As to Claim 30, see discussion of Claim 29 above. Stefik discloses the invention substantially as claimed. Stefik further discloses the playback apparatus further comprises a request unit operable to send, to the semiconductor memory, a request to deduct electric tickets corresponding to the payment determined in accordance with the playback of the digital work (see Stefik, Column 23 Lines 22-27; also see Column 22 Line 60 through Column 23 Line 27).

Stefik does not specifically disclose “wherein another one of the plurality of application functions ... can be used to make a payment for playback of the digital work” and “the semiconductor memory further includes a payment unit operable to deduct ... in accordance with the request from the playback apparatus”. However, the limitations are not part of the claimed playback apparatus and do not fall under the scope of the claimed invention. The limitations are not given patentable weight for the purpose of prior art examination.

As to Claim 31, see discussion of Claim 30 above. Stefik discloses the invention substantially as claimed. Stefik further discloses a control unit operable to obtain, before the digital work is played back by the playback unit, electric ticket information showing remaining electric tickets from the semiconductor memory (see Stefik, Column 22 Lines 60-67), and judge that the digital work is not allowed to be used and prohibit the playback unit from playing back the digital work, when the remaining electric tickets are less than the electric tickets corresponding to the payment determined in accordance with the playback of the digital work (see Stefik, Column 22 Line 60 through Column 23 Line 27).

As to Claim 32, see discussion of Claim 31 above. Stefik discloses the invention substantially as claimed. Stefik does not specifically disclose wherein the request unit sends to the semiconductor memory, a request to deduct electric tickets corresponding to a payment for a playback of one-time, every time the digital work is played back. However, it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. The limitation is not given patentable weight for the purpose of prior art examination.

As to Claim 33, see discussion of Claim 31 above. Stefik discloses the invention substantially as claimed. Stefik does not specifically disclose wherein the request unit sends to the semiconductor memory, a request to deduct electric tickets corresponding to a payment for the playback of the digital work during a predetermined period of time, when the digital work is played back one or more times during the predetermined period of time. However, it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. The limitation is not given patentable weight for the purpose of prior art examination.

With respect to Claim 46, Stefik discloses:

a reading step (see Stefik, Column 14 Lines 5-25; also see Column 9 Lines 55-67) of securely (see Stefik, Column 26 Lines 58-64) comparing right information relating to a right to use the digital work (see Stefik, Column 30, Lines 58-67; also see Column 30 Line 50 through Column 32 Line 5), from an area of a portable semiconductor memory

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(see Stefik, Column 31 Lines 6-15; also see Column 7 Lines 47-65 and Column 14 Lines 5-25);

a judgment step of judging whether the digital work is allowed to be used, based on the red right information (see Stefik, Column 14 Lines 5-25; also see Column 30 Line 14 through Column 32 Line 22 and Column 7 Lines 14-46);

an obtaining step of obtaining the digital work from the storage medium when the digital work is allowed to be used (see Stefik, Column 14 Lines 15-25; also see Column 34 Line 16 through Column 35 Line 4); and

a playback step of playing back the obtained digital work (see Stefik, Column 8 Lines 39-59; also see Column 7 Lines 47-65 and Column 35 Line 65 through Column 36 Line 33).

While Stefik discloses comparing the rights, Stefik does not specifically disclose a function of reading rights. Official Notice is taken that it is old and well known in the art to read information in order to make a comparison, because reading the information prevents corruption of the original source of the information.

With respect to Claim 47, Stefik discloses:

a reading step (see Stefik, Column 14 Lines 5-25; also see Column 9 Lines 55-67) of securely (see Stefik, Column 26 Lines 58-64) comparing right information relating to a right to use the digital work (see Stefik, Column 30, Lines 58-67; also see Column 30 Line 50 through Column 32 Line 5), from an area of a portable semiconductor memory (see Stefik, Column 31 Lines 6-15; also see Column 7 Lines 47-65 and Column 14 Lines 5-25);

a judgment step of judging whether the digital work is allowed to be used, based on the red right information (see Stefik, Column 14 Lines 5-25; also see Column 30 Line 14 through Column 32 Line 22 and Column 7 Lines 14-46);

an obtaining step of obtaining the digital work from the storage medium when the digital work is allowed to be used (see Stefik, Column 14 Lines 15-25; also see Column 34 Line 16 through Column 35 Line 4); and

a playback step of playing back the obtained digital work (see Stefik, Column 8 Lines 39-59; also see Column 7 Lines 47-65 and Column 35 Line 65 through Column 36 Line 33).

While Stefik discloses comparing the rights, Stefik does not specifically disclose a function of reading rights. Official Notice is taken that it is old and well known in the art to read information in order to make a comparison, because reading the information prevents corruption of the original source of the information.

As to Claim 48, see discussion of Claim 47 above. Stefik discloses the invention substantially as claimed. Stefik further discloses program stored in a computer-readable storage medium (see Stefik, Column 14 Lines 5-25).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kupka et al., U.S. Patent No. 6,434,535 B1. Prior art discloses content delivery with storage medium.

Ginter et al., U.S. Patent No. 5,892,900. Prior art discloses time duration for content rendering.

Chica et al., U.S. Patent Application Publication No. 2002/0026445 A1. Prior art discloses uploading and sharing content by multiple sources.

Taira et al., U.S. Patent No. 6,515,212 B2. Prior art discloses media content medium with usage rights.

Basso, Jr. et al., U.S. Patent No. 6,131,900. Prior art discloses access to smartcard.

Although Examiner has cited particular columns, line numbers, and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Furthermore it must be noted that the documents cited on any enclosed PTO-892 or PTO-149 form are cited in their entirety.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571) 270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CALVIN L. HEWITT can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILE SU/
Examiner, Art Unit 3685
May 6, 2009

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685